

DOCKET NO.: MSFT-0103/127334.6
Application No.: 09/482,843
Office Action Dated: February 19, 2003



REMARKS/ARGUMENTS

The following Request for Reconsideration is submitted in response to the Office Action issued on February 19, 2003 (Paper No. 5) in connection with the above-identified patent application, and is being filed within the three-month shortened statutory period set for a response by the Office Action.

Claims 106-135 are pending in the present application, and stand rejected. Applicants respectfully request reconsideration and withdrawal of the rejection of such claims.

Preliminarily, Applicants note that the Disposition of Claims section on the coversheet of the present Office Action is inconsistent with the state of the application and the contents of the Office Action. In particular, the Disposition of Claims section incorrectly notes that claims 1-135 are pending and claims 1-105 have been withdrawn from consideration. Applicants respectfully submit that in point of fact, claims 106-135 are pending, and that claims 1-105 have been canceled.

The Examiner has rejected claims 106-120 under 35 USC § 101 for the reason that such claims are directed to non-statutory subject matter. Applicants respectfully traverse the §101 rejection or object as it may be applied to claims 106-120.

Preliminarily, Applicants respectfully submit that the § 101 rejection is prima facie improper in that the Examiner has failed to specifically apply the Examination Guidelines for Computer-Related Inventions, or at least has not applied such Guidelines in any coherent manner. The Examiner does refer to Box 6 of the Guidelines Flowchart, but does not continue with analysis that is required beyond such Box 6.

Independent claim 106 recites a **digital content package** that includes encrypted digital content to be rendered in accordance with a corresponding digital license. The

package is separate and apart from the license, and the encrypted digital content is decryptable according to a decryption key (KD) obtained from the license. The package also has a content/package ID identifying one of the digital content and the package, and license acquisition information including a location of a license provider for providing the license.

According to the Examiner, the claims are “merely directed to a software package [which] contains [a] computer program per se”, and that such package does not produce a useful result without being acted on by an external entity. In doing so, and again, the Examiner refers to Box 6 of the Guidelines Flowchart. While, such Box 6 states that a computer program per se is not patentable subject matter, Applicants respectfully point out that claims 106-120 are not directed to a computer program per se but to a digital content package.

Further, Applicants respectfully point out that the Examiner is incorrect in characterizing the content of the package as a computer program per se. In point of fact, the package of claim 106 includes the encrypted digital content, the ID, and the license acquisition information, none of which are necessarily computer programs.

The Examiner also states that the external entity that acts on the package of claim 106 must also be claimed. However, Applicants respectfully point out that Section 101 and the Guidelines impose no such requirement.

In particular, and applying the Guidelines, claims 106-120 recite a digital package with a number of digital components therein for delivering encrypted digital content and for providing information necessary to effectuate decrypting the content. Thus, the claimed invention is not a natural phenomenon, nor is the invention merely functional or non-functional descriptive material such as a data structure per se, a computer program per se,

music, etc. Put another way, with the elements therein for delivering encrypted digital content and for providing information necessary to effectuate decrypting the content, the recited package of claim 106 is more than merely an abstract idea without more.

Accordingly, the analysis shifts to Box 8, where it is determined that the claimed package is not a series of steps, and then to Boxes 9, where the package is determined to be a product, but not a specific product such as machine or manufacture. Thus, the analysis continues to Box 12, where the issue is whether the recited package performs independent physical acts OR whether the recited package manipulates data representing physical objects or activities to achieve a practical application. Although Applicants can argue that the answer here is yes, Applicants instead choose to presume for the sake of argument that the answer is no, and therefore proceed to Box 13, where the issue becomes whether the recited package merely is for manipulating abstract ideas or solves a purely mathematical problem without any limitation to a practical application.

Applicants respectfully submit that the answer to Box 13 is no, and that therefore the recited process is statutory subject matter (Box 14). In particular, Applicants argue that the recited package is not merely for manipulating an abstract idea or solving a purely mathematical problem. Instead, the package is part of an overall system that solves a very real and very practical problem: how to provide digital content from a provider to a requestor such that the requestor can render the content while still protecting such content. Moreover, Applicants respectfully submit that it is beyond argument that the solution to such practical problem as represented by the recited package in claim 106 represents a practical application.

In fact, providing a package with such content and related elements represents a huge application to which the employer of the Applicants (and Assignee of the present application) has expended tremendous amounts of research and capital on. Briefly, being able to produce such a package is a cornerstone of being able to distribute encrypted digital content, including but not limited to selling digital audio content and digital multimedia content to consumers. Accordingly, and again, Applicants respectfully submit that the package recited in claims 106-120 does not merely manipulate an abstract idea or solve a purely mathematical problem without any limitation to a practical application, and that therefore such claims 106-120 in fact recite statutory subject matter according to the Examination Guidelines for Computer-Related Inventions.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that claims 106-120 recite patentable subject matter under section 101. Thus, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection.

The Examiner has rejected claims 106 and 121 under 35 USC § 112, second paragraph. Applicants respectfully traverse the § 112 rejection.

According to the Examiner, “the package being separate and apart from the license” in claim 106 lacks antecedent basis since the claim recites the package and not the license. However, Applicants respectfully submit that “the package” in line 3 of the claim is supported by “a digital content package” in line 1, and “the license” in line 3 is supported by “a corresponding digital license” in lines 2-3. Moreover, Applicants respectfully submit that they are not required to positively recite the license within the claim, as the Examiner seems to imply, but may in fact inferentially refer to such license without so positively reciting same.

The Examiner also takes issue with “a content/package ID” and with “identifying one of the digital content and the package” as being unclear. However, Applicants respectfully submit that such ID is a content/package ID inasmuch as such ID can refer to either the content or the package, and that in such context each of the terms is clear.

The Examiner identifies similar issues with regard to claim 121, to which Applicants respond in a similar manner to that as set forth immediately above.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that claims 106 and 121 satisfy section 112. Thus, Applicants respectfully request reconsideration and withdrawal of the § 112 rejection.

The Examiner has rejected claims 106-135 under 35 USC § 103(a) as being obvious over Stefik (U.S. Patent No. 5,715,403) in view of Krishnan (U.S. Patent No. 6,073,124). Applicants respectfully traverse the § 103(a) rejection.

Independent claim 106 was referenced above. Independent claim 121 recites subject matter similar to that in independent claim 106, but in the form of a computer-readable medium with a data structure thereon embodying the package of claim 106.

The Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are stored and accessed from such repositories, and are transferred only between such repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., a license with license terms) are attached to digital works in the Stefik system, and both the work and its attached license are transmitted from a serving repository

(at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a package with encrypted digital content, where the package is separate and apart from a corresponding license, as is required by claims 106 and 121. Moreover, the Stefik package would not include license acquisition information for acquiring a license, as is required by claims 106 and 121, inasmuch as the license is already attached to the Stefik package and thus need not be acquired.

Further, the Stefik reference does not disclose that the Stefik package has a content or package ID, as is required by claims 106 and 121. Although the Examiner points to element number 1207 in Fig. 12 as showing such an ID, Applicants respectfully point out that such element number 1207 is in fact a storage system for storing Stefik packages.

The Krishnan reference discloses a system for facilitating digital commerce wherein a client obtains content from a content server and then obtains an electronic license certificate (ELC) or license from a licensing broker / server. However, and significantly, the Krishnan reference does not at all disclose or suggest that the content be in a package with a content/package ID identifying one of the content and the package, as is required by claims 106 and 121.

Thus, Applicants respectfully submit that the combination of the Stefik and Krishnan references does not make obvious independent claims 106 and 121 or any claims depending therefrom. Instead, Applicants respectfully submit that such claims are not in fact obvious in view of the cited references, and accordingly, Applicants respectfully request reconsideration and withdrawal of the first § 103(a) rejection.

The Examiner has also rejected claims 130-135 under 35 USC § 103(a) as being obvious over the Stefik reference in view of the Official Notice. Applicants respectfully traverse this additional § 103(a) rejection.

Applicants respectfully submit that since independent claims 121 is unanticipated and has been shown to be non-obvious, then so too must all claims depending therefrom be unanticipated and non-obvious, including claims 130-135, at least by their dependency.

Moreover, Applicants respectfully point out that the Examiner has improperly taken Official Notice in rejecting claims 130-135 under § 103(a). As stated in MPEP 2144.03, the rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. In particular, the Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art (emphasis added). Thus, Applicants respectfully submit that official notice is meant to be taken with regard to facts that on their face are undeniable, such as 'water boils upon being sufficiently heated', 'gravity pulls objects toward each other', and 'gasoline is combustible'. In contradistinction, Applicants also respectfully submit that official notice is not meant to be taken with regard to facts such as particular items that may be included with a computing data structure, especially if such data structure can be operated without the particular items.

MPEP 2144.03 also sets forth that assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work, and allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported. Significantly, officially noticed facts are intended to fill the gaps

which might exist in an evidentiary showing and should not comprise the principle evidence upon which a rejection is based.

Applicants respectfully submit that many if not most of the elements or limitations of which Official Notice are taken are not even facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art. For example, the Examiner takes Official Notice that it is known for a certificate to include a public key of a content provider. Unquestionably, such a fact is not capable of instant and unquestionable demonstration as being well known, and can certainly be open to question.

Applicants likewise submit that many if not most of the other elements or limitations for which Official Notice are taken are likewise not truly facts capable of instant and unquestionable demonstration as being well known, and instead certainly open to question. Thus, Applicants request that the Examiner support each and every taking of Official Notice with suitable evidence.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the additional § 103(a) rejection.

Applicants note that the Examiner at or about page 11 ambiguously states that all claimed features contain capabilities of computer systems, and then seems to imply that merely being capable of being instantiated on a computer system makes the claims obvious. Applicants respectfully disagree, and respectfully submit that such blanket statements cannot satisfy the requirement that the Examiner make a prima facie case of obviousness under Section 103(a). In particular, Applicants respectfully point out that such blanket statements amount to a blanket rejection of the claims without providing any specific details. Moreover,



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such blanket statements do not at all provide any indication of why the cited references should or could be combined to produce the invention recited in the claims.

In view of the foregoing discussion, Applicants respectfully submit that the present application, including claims 106-135 is in condition for allowance, and such action is respectfully requested. Should the Examiner disagree, Applicants respectfully request that the Examiner telephone the undersigned at the number below to arrange an in-person interview with the Examiner and the Examiner's supervisor to discuss the present Office Action.

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